

DETAILED ACTION

1. This following is a **final action** on merits in response to the communication received on **2/26/08**.

Acknowledgement

2. The amendments received on **2/26/08** have been entered. The new **claim 11** is added. The **claims 1, 4, and 8** are amended. As such the **claims 1-11** are pending.

DETAILED ACTION

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Slater** (2003/0033246) in view of **Helges** et al (2004/023662).

As per claim 1, Slater discloses a method of paying tuition and related college or university expenses comprising:

identifying those tuition and related education expenses (para **0051**, lines 10-13; via tuitions and other cost associated with college) which can be paid from funds in the Section 529 investment account;

providing the benefactor (student) a debit card usable by the benefactor (cardholder-student) to pay the tuition and related education expenses as they arise (para **0041**, lines 5-10; via sponsor funded stored value card [like a debit card- no deposit account]);

debiting the investment account by the amounts paid using the debit card (see para **0030** and **Fig.1 #32**; via withdrawing funds as cash at an ATM);and

However, **Plater** fails to explicitly disclose the step of establishing and funding a Post-secondary education investment account in accordance with Internal Revenue Service rules and regulations, the account being established for a named benefactor and electronically qualifying and substantiating such paid amounts to provide a record of the expenses in accordance with the United States Internal Revenue Service reporting requirements for the post-secondary education investment account.

Helges in the same field of invention discloses the step of establishing and funding a Post-secondary education investment account in accordance with Internal Revenue Service rules and regulations, the account being established for a named benefactor and electronically qualifying and substantiating such paid amounts to provide a record of the expenses in accordance with the United States Internal Revenue Service reporting requirements for the post-secondary education investment account (see para **0045-0048[Fig.1]**, line 7; via computer readable medium, Internet, database

101 and para **0075-0076**, line 12; via projected qualified education expenses related to accounts of 529 plan and also in para **0079 [Fig.23]** operational sequence.. education expense analysis and projected calculations inherently electronically expense report)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the disclosure and the features mentioned by **Slater** and to include the disclosure as taught by **Helges** to facilitate in order to have the Section **529** College Investment plans (para **0062**, line 8).

As per claim 2, Plater discloses the step of identifying those tuition and related expenses which can be paid from investment account funds includes identifying both on-campus and off-campus facilities at which purchases may be made using the debit card, and identifying the types of expenses which can be paid for at those facilities using the card (para **0054**, lines 13-25; via stored valued card transaction in university and outside grocery store, book store, apartments etc.).

As per claim 3, Plater discloses the steps of including pre-approving the expenses, which can be paid for using the debit card prior to the benefactor using the debit card to pay for expenses incurred at those facilities (para **0051**, lines 10,16; via funds may cover tuition, books, room, lab supplies and other cost associated with college inherently pre-approved and predetermined amount of the money to be received).

As per claim 4, Plater discloses the steps of including establishing a central database for all colleges and universities, and on-campus and off-campus facilities at those institutions which are approved for use with the investment account, so any

benefactor of the post-secondary education investment account can use their debit card at those institutions and facilities (para **0051**; via use of card on or off campus)

As per claim 5, *Plater* discloses the steps of including recording of those expenses paid for by the benefactor using their debit card, subtracting those expenses from the amount in the investment account, and providing a record of the expenses and the balance remaining in the account (para **0054**; via recording of transactions and keep track of expenditure to ensure that the debits and credits to the stored value card have been made).

As per claim 6, *Plater* discloses that the benefactor must use a personal identification number or authorization code each time an expense is paid for using the debit card, so to protect the benefactor and the account (para **0026**, line 9-16; via unique reference number not on the card).

As per claim 7, *Plater* discloses that the debit card is usable for point-of-purchase transactions (see para 0030; via making a POS purchase).

As per claim 8, *Plater* discloses that the debit card is further usable for wire transfers, telephonic transactions, and Internet transactions (para **0040**; via transaction I/O module **154** online purchase).

As per claim 9, *Plater* discloses the steps of further including charging the benefactor (student- cardholder) a fee for use of the debit card (para **0042**; via transaction fees paid by cardholders).

As per claim 10, *Plater* discloses the steps of further including charging colleges, universities, and the on-campus and off-campus facilities a fee for inclusion in

Art Unit: 3692

a database of approved sites where the debit card can be used (para **0051**; via funds covering other costs associated with college inherently any fees also included).

As per claim 11, *Plater* discloses a method of paying tuition and related college or university expenses comprising:

identifying those tuition and related education expenses which can be paid from funds in the post-secondary education investment account by identifying both on-campus and off-campus facilities at which purchases may be made using the debit card and pre-approving the types of tuition and related education expenses which can be used from the funds in the post-secondary education investment account (para **0051**, lines 10-13; via tuitions and other cost associated with college).

providing the benefactor (student) a debit card usable by the benefactor (cardholder-student) to pay the tuition and related education expenses as they arise (see para **0041**, lines 5-10; via sponsor funded stored value card [like a debit card- no deposit account]);

debiting the investment account by the amounts paid using the debit card (see para **0030** and **Fig.1 #32**; via withdrawing funds as cash at an ATM); and

However, ***Plater*** fails to explicitly disclose the step of establishing and funding a Post-secondary education investment account in accordance with Internal Revenue Service rules and regulations, the account being established for a named benefactor and electronically qualifying and substantiating such paid amounts to provide a record of the expenses in accordance with the United States Internal Revenue Service reporting requirements for the post-secondary education investment account.

Helges in the same field of invention discloses the step of establishing and funding a Post-secondary education investment account in accordance with Internal Revenue Service rules and regulations, the account being established for a named benefactor and electronically qualifying and substantiating such paid amounts to provide a record of the expenses in accordance with the United States Internal Revenue Service reporting requirements for the post-secondary education investment account (see para **0045-0048**[Fig.1], line 7; via computer readable medium, Internet, database **101** and para **0075-0076**, line 12; via projected qualified education expenses related to accounts of 529 plan and also in para **0079** [Fig.23] operational sequence.. education expense analysis and projected calculations inherently electronically expense report)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the disclosure and the features mentioned by **Plater** and to include the disclosure as taught by **Helges** to facilitate in order to have the Section 529 College Investment plans (para **0062**, line 8)

Response to Arguments

5. Applicant's arguments with respect to **claims 1-11** have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, see the abstract and also para **0009**, line 7; via 529 college investment plan to take the advantage of tax-deferred growth [*Helges*]).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pitroda (2003/0115126) discloses System and Method for Servicing Electronic Transaction.

Speckman (2003/09724) discloses Tool for Analyzing Investment Plans.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed H. Ali whose telephone number is 571-270-3021. The examiner can normally be reached on 8.00 to 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA

Mohamed H Ali
Examiner
Art Unit 3693

/Harish T Dass/

Art Unit: 3692

Primary Examiner, Art Unit 3692